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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,931	01/23/2004	Nady E. Nady	5032-105 US	7857

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EXAMINER	
COMSTOCK, DAVID C	

ART UNIT	PAPER NUMBER
3732	

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/763,931	NADY, NADY E.	
	Examiner	Art Unit	
	David Comstock	3732	

-- The MAILING DATE of this communication appears on the c ver sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Nestor et al. (4,099,521).

Nestor et al. disclose a retractor device comprising an elongated element S adapted to be mounted to a surgical table via clamp B (see Fig. 1). An elongate curved arm 20 is slidably mounted on the elongated element via slide member 25. The elongate arm comprises a plurality of open channels 34 slidably mounted thereon. The device includes a plurality of flexible elements 35, which are received on the elongate arm (see Figs 2, 8 and 9). Bifurcate gripping elements 36 are attached to the flexible elements (see Fig. 10). Each of the flexible elements comprises a plurality of raised circular portions and is received in the open channels (see Figs 2, 8 and 9). Nestor discloses using the device to retract body skin folds, i.e. retracted cheek skin around the mouth (see Fig. 2 and col. 5, line 62 - col. 7, line 42). It is noted that cheek skin comprises fat folds or excess skin folds in the obese or elderly, for example. With regard to claims 13-15, it is noted that claims directed to the structure of the apparatus are not entitled to patentable weight in claims directed to the process of using the device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nestor et al. (4,099,521) in view of Lange (5,709,646).

Nestor et al. disclose the claimed invention except for providing a replaceable elastomeric cover. Lange discloses a retractor 30 having a replaceable elastomeric cover 12 to reduce slipping in the body cavity, to reduce trauma to tissue and to ease the workload on surgical personnel (see Figs. 1-3 and col. 1, lines 56 - col. 2, line 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the retractor device of Nestor et al. with a replaceable elastomeric cover, in view of Lange, in order to reduce slipping in the body cavity, to reduce trauma to tissue, and to ease the workload on surgical personnel.

Response to Arguments

Applicant's arguments filed 27 October 2004 have been fully considered but they are not persuasive.

In response to Applicant's argument that Nestor does not anticipate Applicant's invention, it is noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order

to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, Applicant is arguing limitations not recited in the claims. It is noted that the features upon which applicant relies (i.e., retracting "bannus") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Regardless, it is noted that cheek skin comprises fat folds or excess skin folds in the obese or elderly, for example. Furthermore, each of the flexible elements are received in one of the open channels of elements 34, as already set forth in the rejection (see Figs. 2, 8 and 9). The raised circular portions of the flexible elements 35 are also received or supported by the open channels, and in fact, it is this configuration that allows the flexible elements to be retained in the device. It is noted that the specification must set forth the definitions of claim terminology explicitly and with reasonable clarity, deliberateness, and precision. Exemplification is not an explicit definition. Even explicit definitions can be subject to varying interpretations. See *Teleflex, Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP 2111.01.

In response to Applicant's argument that Lange (5,709,646) does not render Applicant's invention obvious, it is noted that Lange has not been cited as disclosing a gripping device used to retract fat folds or excess skin, as suggested by Applicant in the Remarks. Nestor already discloses this aspect of the invention. Rather, Lange teaches the desirability of providing a retractor with a replaceable elastomeric cover, as already set forth in the rejection. Applicant cannot establish nonobviousness by attacking the Lange reference individually with respect to claim elements already taught by Nestor et al., where the rejection is based on the combination of the Nestor et al. and Lange references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.

DC

D. Comstock
17 January 2005

EDUARDO C. ROBERT
PRIMARY EXAMINER